

REMARKS

Applicants acknowledge receipt of an Office Action dated December 28, 2007.

Claims 22-29 have been added. Claims 1-29 are currently pending.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Objections to the Specification

The specification and abstract have been objected to for containing informalities. The specification and abstract have been amended to overcome these objections. Applicants respectfully request reconsideration and withdrawal of these objections.

Rejections Under 35 U.S.C. § 102

Claims 1, 3, 4, 6, 10, 11, 19, and 21 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 6,212,982 to Buchanan *et al.* (hereafter “Buchanan”). Applicants respectfully traverse this rejection.

Buchanan discloses a heat exchanger that can be an automotive air conditioning system condenser. See col. 5, lines 4-6, of Buchanan. However, Buchanan does not disclose a charge-air cooler for motor vehicles, as recited in claim 1. A condenser, as disclosed by Buchanan, is configured to process at least a liquid phase and a gas phase, while a charge-air cooler is configured to process two gas phases. Therefore, a condenser is not configured in the same way as a charge-air cooler because a condenser would have a different configuration with different dimensions in order to process the different phases and conditions, such as pressure, that a charge-air cooler would not have to process.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP § 2131. Buchanan does not anticipate claim 1 because Buchanan does not disclose all of the features of claim 1.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 102.

Claims 1, 5, 10, 12, 19, and 21 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 2002/0066553 to Fischer *et al.* (hereafter “Fischer”). Applicants respectfully traverse this rejection.

Fisher discloses a heat exchanger, in particular an evaporator for a vehicle air-conditioning system. See paragraph 0016 of Fischer. An evaporator, similar to the condenser of Buchanan, is

configured to process at least a liquid phase and a gas phase. Fischer does not disclose the charge-air cooler of claim 1 because the evaporator of Fischer would also have a different configuration with different dimensions in order to process the different phases and conditions, such as pressure, that a charge-air cooler would not have to process. Therefore, Fischer does not anticipate claim 1 because the evaporator of Fischer is configured differently than a charge-air cooler.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 102.

Rejection Under 35 U.S.C. § 103

Claims 2 and 13-18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Fischer. Applicants respectfully traverse this rejection for the reasons set forth below.

Fischer does not provide a proper ground of rejection under 35 U.S.C. § 103(a) because Fischer does not disclose or suggest all of the features of claim 1, which claims 2 and 13-18 depend from. The Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.* has not removed the requirement that a prior art reference, or references when combined, must teach or suggest all of the claim limitations. In fact, *KSR* emphasized cases in which all features were found in prior art references.

For example, the Court noted three cases: *United States v. Adams*, 383 U.S. 39 (1966), *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), and *Sakraida v. AG Pro, Inc.*, 425 U.S. 273 (1976), which all dealt with the issue of whether the combination of known elements would have been obvious. The Court stated that “*Sakraida* and *Anderson's-Black Rock* are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” 127 S.Ct. 1727, 1740 (2007). In another example, the *KSR* Court stated that “[a]s is clear from cases such as *Adams*, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the art...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed invention does.” *Id.* at 1741. Such statements reinforce the concept that all elements of a claim have to be known in the art before they are determined to be combinable or not. Furthermore, the Court in *KSR* stated that a reason to combine elements should be made explicit. *Id.* at 1740-41.¹ Indeed, the Court

¹ “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.” *Id.* at 1740-41.

approvingly cited *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006), for requiring an articulated reason. *Id.* at 1741.²

In addition, the PTO's examination guidelines for determining obviousness in view of *KSR*³ suggests that all elements (when the references are combined) need to be known in the art to support a conclusion of obviousness.⁴

Fischer does not provide a proper basis for a conclusion of obviousness because Fischer does not disclose or suggest all of the features of claim 1. Reconsideration and withdrawal of this rejection is respectfully requested for at least the reasons set forth above.

Claims 7, 8, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fischer in view of DE 19953785 to Heine (hereafter "Heine"). Applicants respectfully traverse this rejection for the reasons set forth below.

The combination of Fischer and Heine is not a proper basis for a conclusion of obviousness because does not disclose all of the features of claim 1. As discussed above, Fischer discloses an evaporator. Heine discloses a radiator for engine coolant. See abstract of Heine. The combination of Fischer and Heine does not provide a charge-air cooler, as recited in claim 1, because both Fischer and Heine disclose devices that are configured to process at least a liquid phase and a gas phase.

² "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" *Id.* at 1741.

³ "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex, Inc.*" (Pages 57526-57535 of the Federal Register, Vol. 72, No. 195.)

⁴ For example, if a finding that all claim elements were known in the prior art cannot be made, then the rationale of combining prior art elements according to known methods cannot be used. (Page 57529.) If a finding that the substitution of one known element for another known element (which suggests a teaching of the known elements in the prior art) cannot be made, then the rationale of simple substitution of one known element for another cannot be used. (Page 57530.) If a finding that a method of enhancing a particular class of devices, methods or products based upon the teaching of such an improvement in other situations cannot be made, then the rationale of the use of known techniques to improve similar devices in the same way cannot be used. (Page 57530.) If a finding that a particular known technique was recognized in the art (which suggests a teaching of the technique in the prior art) cannot be made, then the rationale of applying a known technique to a known device, method, or product ready for improvement cannot be used. (Page 57531.) If a finding that there are known options within the grasp of a person of ordinary skill (which suggests a teaching of the known options in the prior art) cannot be made, then the rationale of obvious to try cannot be used. (Page 57532.) If a finding that design incentives or other market forces could have prompted one of ordinary skill to vary the prior art in a predictable manner (which suggests a teaching of the predictable manner in the prior art) cannot be made, then the rationale of the known work in one field of endeavor may prompt variations of it for use in either the same field or a different one cannot be used. (Page 57533.) If a finding that a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention (which suggests that the prior art when combined teaches all the elements of the claimed invention) cannot be made, then the rationale of some

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections under § 103.

Allowable Subject Matter

Applicants gratefully acknowledge the indication that claim 9 contains allowable subject matter. Claim 9 has been amended to be placed in independent form.

New Claims

New claims 22-29 have been added. Claims 22-29 depend from claim 1 and are allowable over the prior art for at least the reasons discussed above and for their respective additional recitations.

CONCLUSION

Applicants submit that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify or combine prior art reference teachings cannot be used. (Page 57534.)